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09/807,697	04/17/2001	Sylvain Chevreau	PF980072	2501

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EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/807,697

Applicant(s)

CHEVREAU ET AL.

Examiner

Bradley Bayat

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 1-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-12 are presented for examination on the merits. Applicant's preliminary amendment (paper #4) filed on 27 February 2002 has been entered.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 371 and receipt of a copy of the international application.

#### ***Specification***

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms that are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. It appears that the disclosure is a direct translation from the foreign application and often translators use words that do not describe the subject matter at hand precisely and the meaning is often lost during translation. For example, the primary object of applicant's invention is to "prevent" unauthorized copying rather than "avoid" (page 2). It behooves the applicant to thoroughly review the specification and amend the language of the specification so as to capture the spirit of the claimed invention, without adding any new matter.

Furthermore, applicant's attempt to incorporate subject matter into this application by reference to the "French patent application" (pages 6 and 7 of the specification) is improper.

#### ***Claim Objections***

Claims 1-12 are objected to because of the following informalities: The claims are replete with grammatical errors and unnecessary wording. For instance, the applicant need to claim in the preamble what the invention is not or "avoids" being, the applicant must claim the

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invention. Furthermore, the applicant at the beginning of each dependent claim refers to "the method as claimed in claim..." The applicant need only refer to "the method of claim..." instead of adding unnecessary language. In addition, each steps described in each claim should be separated by a semicolon rather than a comma for clarification.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim (s):

- Claim 1: The terms "function" and "writing" are vague and indefinite. It is unclear how the digital data is formatted as a "function" of a serial number and how said data is written or perhaps encoded on the medium.
- Claim 2: The terms "unfalsifiable manner on the medium during its manufacture" are vague and unclear as above.
- Claims 3, 12: The terms "low probability of being common to two media" are relative terms, which render the claim indefinite. The phrase is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

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- Claim 4: The terms "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
- Claim 7: After the term "recoding" the applicant fails to specify what is being recorded, therefore that step fails to perform any function.

The applicant is advised to review all claims to ensure that all the claims meet the requirements under 35 U.S.C. 112, second paragraph, the examiner has provided the above instances as guide for the applicant. For the most part, the claims are vague, unclear and do not particularly point out and distinctly claim the subject matter applicant claims as the invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Söhne et al. (hereinafter Söhne), U.S. Patent 6,397,333 B1.**

As per claim 1, Söhne discloses a method of copying which avoids the bit-by-bit duplication of digital data arising from a source of digital data on a medium, wherein said method comprises a step of formatting the digital data arising from said source of digital data as a function of a serial number contained in said medium and a step of writing said formatted data onto said medium (column 2, lines 25-57).

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As per claim 2, Söhne discloses the method as claimed in claim 1, wherein the serial number is recorded in an unfalsifiable manner on the medium during its manufacture (column 2, lines 58-62).

As per claim 3, Söhne discloses the method as claimed in claim 1, wherein the serial number is a unique number for each medium or exhibits a low probability of being common to two media (column 4, lines 50-51).

As per claim 4, Söhne discloses the method as claimed in claim 1, wherein the step of formatting of the digital data to be duplicated is carried out using a secret-key encryption algorithm such as DES or a public-key algorithm such as RSA (figures 1, 2 and associated text; column 2, lines 63-67).

As per claim 5, Söhne discloses the method as claimed in claim 4, wherein the encryption key is dependent on the serial number (figure 1 and associated text).

As per claim 6, Söhne discloses the method as claimed in claim 5, wherein the encryption key is furthermore dependent on a secret parameter contained in any reading device adapted for reading the digital data arising from said source (figure 1 and associated text).

As per claim 7, Söhne discloses a method of copying which avoids the bit-by-bit duplication of digital data read by a reading device and copied onto a medium, wherein the medium comprises a serial number and in the method of copying comprises the following steps:

- sending of the serial number recorded on the medium to the reading device (column 2, lines 25-57),
- formatting of the digital data read with the aid of the serial number (column 2, lines 25-57), and

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- recording on said medium of the formatted digital data (column 2, lines 25-57).

As per claim 8, Söhne discloses the method as claimed in claim 7, wherein the formatting step is carried out in the reading device (figure 1 and associated text).

As per claim 9, Söhne discloses the method as claimed in claim 7, wherein the reading device comprises means making it possible to read the medium containing the formatted digital data (column 2, lines 54-57).

As per claim 10, Söhne discloses the method as claimed in claim 7, wherein before performing the duplication of the digital data, it comprises a step of checking authorization to copy (column 3, lines 23-30).

As per claim 11, Söhne discloses a reading device allowing the implementation of a method of copying according to claim 1, wherein it comprises a formatting circuit adapted for receiving the serial number of the medium onto which the digital data are to be copied and providing as output, formatted data which are dependent on said serial number and are intended to be copied onto said medium (figure 1 and associated text).

As per claim 12, Söhne discloses a recording medium for digital data comprising a serial number which is unique or exhibits a low probability of being common with that of another medium, wherein it furthermore comprises recorded digital data, said digital data being formatted as a function of said serial number and of a secret parameter (figures 1 and 2 and associated text).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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- U.S. Patent 6,134,659 to Sprong et al.

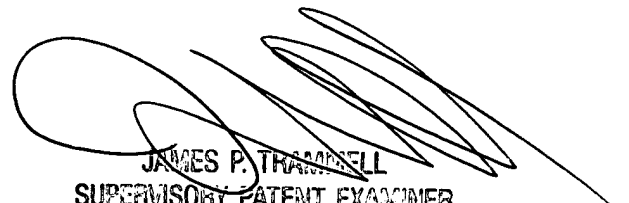
Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5484.

bbb  
December 12, 2003

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3300